

REMARKS

Claims 1-23 were originally filed, claims 2-3 and 17-23 were previously canceled without prejudice, claims 24-35 were previously added, claims 1, 11-15, 24 and 29 are currently amended, and claims 36-39 are new. Accordingly, 5 claims 1, 4-16, and 24-39 are pending. In view of the following remarks, Applicant respectfully requests that the application be forwarded on to issuance.

The Claim Objections

10 Claims 1, 11-16, 24-25, and 27-29 stand objected to for informalities.

Applicant amends claims 1, 11-16, 24, and 29 to address the Office's objections with the understanding that these amendments are solely formal—rather than substantive—in nature. The objection to claim 25 is obviated by the amendment to claim 24 on which claim 25 depends.

15 Regarding claim 27, Applicant asserts that the objection to the phrase “the attributes” is improper; claim 26 contains a phrase “of attributes” to which “the attributes” refers.

Regarding claim 28, Applicant asserts that the objection to the phrase “the attributes” is improper; claim 26 contains a phrase “of attributes” to which 20 “the attributes” refers.

35 U.S.C. §103

Claims 1, 4-16, and 24-35 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,870,771 to Oberg (hereinafter, 25 “Oberg”) and further in view of U.S. Patent No. 6,088,138 to Sakai et al. (hereinafter, “Sakai”).

Applicant submits that the Office has failed to establish a *prima facie* case of obviousness and, in view of the comments below, respectfully traverses the Office's rejections. Before discussing the substance of the Office's rejections, however, a section entitled "The §103 Standard" is provided and
5 will be used in addressing the Office's rejections.

The §103 Standard

To establish a *prima facie* case of obviousness, three basic criteria *must* be met. First, there must be some suggestion or motivation, either in the
10 references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091,
15 231 USPQ 375 (Fed. Cir. 1986). Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

Further, the evidence on which an obviousness rejection is based must be set forth in the Office Action.

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Explicit findings on motivation or suggestion to select the claimed invention should also be articulated in order to support a 35 U.S.C. 103 ground of rejection. *Dillon*, 919 F.2d at 693, 16 USPQ2d at 1901; *In re Mills*, 916 F.2d 680, 683, 16 USPQ2d 1430, 1433 (Fed.
25 Cir. 1990). Conclusory statements of similarity or motivation, without any articulated rationale or evidentiary support, do not constitute factual findings.

MPEP 2144.08 III.

The examiner bears the burden of establishing this *prima facie* case of obviousness. As required in the MPEP 2142 (emphasis added):

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The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. *If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness.*

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Therefore, when patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine or modify the references relied on as evidence of obviousness. The need for specificity pervades this authority. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (“particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed”).

20 Thus, the Office must provide factual evidence establishing nonobviousness rather than conclusory statements of motivation to establish a *prima facie* case of obviousness.

Failure to Establish a *Prima Facie* Case

25 First, the Office fails to establish a *prima facie* case of obviousness by failing to factually support its conclusion of obviousness. The Office, in attempting to establish its *prima facie* case under 103, writes:

5 It would have been obvious to an ordinary [person] skilled in the art at the time of the invention to combine the large format printer of Sakai to the system of Oberg to print images of variables sizes including large-scale images at the user's request in very short time for user's convenience.

10 Present Action, sections 8 and 13. This writing states the Office's conclusion but does not provide evidence in support of that conclusion. The motivation "in very short time for user's convenience" is too general to establish factual support.

15 The Office is referred to the USPTO website for an article concerning formulating and communicating rejections under 35 U.S.C. 103 related to computer-implemented inventions. In this Article, the USPTO provides, in Section V, entitled "Examples of Improper Rejection under 35 U.S.C. 103", an exemplary *improper* rejection under 103 (*italic emphasis added*):

c. Poor statement of the rejection

20 Claim 1 is rejected under 35 U.S.C. 103 as being unpatentable over Reference A in view of Reference B. Reference A discloses the conventional use of a smart card to track consumer preferences and provide incentives. However, Reference A does not disclose the automatic notification to consumer providing incentives. Reference B discloses providing incentives to consumers to purchase the
25 desired products. It would have been obvious to combine Reference A's smart card with Reference B's incentive to consumers *because the combination would allow Reference A's smart card to be more efficient.*

d. Analysis

30 The motivation, *improve efficiency*, is too general because it could cover almost any alteration contemplated of Reference A and *does not address why this specific proposed modification would have*

5 *been obvious.* Additionally, there is nothing in either of references that would suggest automatically notifying the consumer when reaching a threshold nor is there anything in either reference that would suggest the notifying step. Finally, although Reference B teaches a traditional coupon scheme to promote customer loyalty, there is no suggestion, other than applicant's disclosure, to employ this scheme to promote the introduction of new and alternative products. **The rejection is improper.**

10 See www.uspto.gov/web/menu/busmethp/busmeth103rej.htm#E17.

15 It is telling that the USPTO considers the above-cited motivation "to be more efficient" given in support of the above exemplary rejection under 103 to be insufficient. Applicant considers the Office's motivation given in the current Office Action "in very short time for user's convenience" to be similarly general to a motivation "to be more efficient" admonished by the USPTO. The Office's stated motivation does not address why this specific proposed modification would have been obvious, thereby making it too general. According to the above article, a motivation that "does not address why [a] specific proposed modification would have been obvious" is "too general". Also, the motivation given by the Office does not follow the MPEP 20 2144.08 III, which requires explicit findings. Further, this motivation does not establish particular findings as required by the Federal Circuit in *In re Kotzab*. For at least this reason, the Office fails to establish a *prima facie* case of obviousness.

25 Second, the Office fails to establish a *prima facie* case of obviousness by failing to establish a motivation to combine Oberg with Sakai sufficient to overcome Oberg's teachings in contravention to a combination with Sakai.

Oberg recites the following:

5 In the *preferred embodiment*, the present invention is designed to allow a customer to bring in *artwork or other objects* that they desire to have framed, input an image of the artwork into a microprocessor, and have the image displayed on video monitor. The software 26 allows the user to crop the input image and select images of frame moulding and matting materials. Therefore, *a key feature* of the present invention is the use of an image generator such as a digital camera that is capable of providing a digital snapshot image of an object such as a painting or other object of artwork to the microprocessor 22.

15 Oberg, column 5, lines 49 to 59, emphasis added. Oberg teaches that the preferred embodiment of his invention is designed to allow a customer to bring in artwork or other objects that they desire to have framed. Oberg also teaches that a key feature of his invention is the use of an image generator capable of providing an image of an object. Applicant notes that artwork and other objects brought in by a user, as well as frames for these objects, are pre-existing and thus generally do not need to be printed. Through these teachings, Oberg teaches away from combining Oberg with Sakai. The Office, however, has not provided evidence sufficient to establish a motivation to combine Oberg with Sakai, especially in light of these teachings of Oberg.

25 Applicant respectfully asserts that the Office has failed to establish its initial burden of factually supporting a *prima facie* case of obviousness. For this reason, Applicant is under no obligation to submit evidence of nonobviousness (*See* MPEP 2142, *supra*).

According, Applicant respectfully requests that the rejection of the pending claims under 103 be withdrawn.

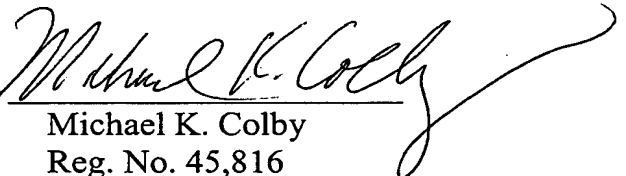
Conclusion

Applicant respectfully submits that all of the claims are in condition for allowance. Accordingly, Applicant respectfully requests that the Office issue a Notice of Allowability. If the Office's next anticipated action is anything other than a Notice of Allowability, Applicant respectfully requests a phone call to discuss scheduling an interview.

Respectfully Submitted,

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